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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,937	10/07/2003	Thomas B. Stanford JR.	B-4588NP 620930-1	6021

7590 07/13/2006

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT PAPER NUMBER

1655

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,937	Applicant(s) STANFORD ET AL.	
	Examiner Dr. Kailash C. Srivastava	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicants' responsive amendment filed 27 April 2006 to Office Action mailed 22 March 2006 is acknowledged and entered.
2. Examiner very much appreciates that applicants label each page of the response and amendment referred above with Application Serial Number, Document Page number, Group Art Unit Number and Examiner name. This practice immensely ameliorates the chances of papers lost during transaction/transmission. Examiner suggests that for the prosecution of application to be further expedited especially during a telephonic conversation/interview with applicant/applicants' representative, applicants should also recite in the header of the each page of response/amendment, the Attorney Docket Number along with date of amendment/response.

Claims Status

3. Claims 18-30 have been added.
4. Claims 1-30 are pending.

Restriction/Election

5. Applicants' election with traverse of Group II, Claims 14-17 and newly added claims 18-30 that also read on elected invention as well as election of species to α -amylase and gluconic acid for prosecuting claims 15-16 filed 28 April 2006 to election requirement in Office Action mailed 22 March 2006 is acknowledged and entered. Acknowledging that there is more than one invention in the instant application, applicants' traversal is on the ground (s) that said restriction requirement in the Office Action mailed 22 March 2006 should be withdrawn because:
 - a. 35 U.S.C. 121 authorizes, not requires that the USPTO restricts an application to one invention if two or more independent inventions are claimed in one application;
 - b. applicants will incur a lot of expense if the two inventions are not examined in one application;
 - c. applicants remind the Examiner that M.P.E. P. §803 states that an Examiner *must examine on merits all the inventions in a given application, if the search and examination of all the claims in an application can be made without serious burden*;
 - d. applicants' opinion is that examination of Claims 1-30 with multiple species does not pose a serious burden to examine all claims together with respective species in one application; and
 - e. all the claims belong in the same "technological classification" (i.e., class 435).

6. Examiner has fully and carefully considered applicants' arguments cited *supra*, but does not find those arguments persuasive because of the reasons of record and for the reasons given below.

Contrary to Applicants' contention, the invention encompassing Claims 1-13 in Group I and one encompassing originally presented claims 14-17 together with newly added claims 18-30 in Group II are distinct from each other because invention in Group I is drawn to a device, whereas the invention in Group II is drawn to a method to detect a microorganism. As to the cost of prosecuting two different inventions in two different applications the determination rests with the applicants, despite the fact that applicants have brought in the limitations of Claims 1-13 in newly presented Claims 18-30 and made Claims 18-30 dependent on method Claim 14 and are thus getting the prosecution of all the claims in one application. Additionally, each one of the inventions in Groups I-II belongs to a different classification because as applicants are well aware a technological classification encompasses both Class and subclass. Moreover, the search for each of the distinct inventions of Groups I-II is not co-extensive particularly with regard to the literature search. For example the search strategy for the device invention of Group I would require different key words and combinations thereof than those required for the method Claims in Group II because, despite having common components by virtue of encompassing limitations of claims 1-13 in Claims 18-30, the above-referred inventive Groups differ from each other in functional effects and steps. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Moreover, the examination burden lies not only in the search of U.S. patents, burden also lies in the search for non-patent literature and foreign patents and examination of the claim language and specification for compliance with the statutes concerning new matter, distinctness and scope of enablement. Thus, clearly, different searches and issues are involved with each inventive group cited *supra*. Finally, the condition for patentability is different for each of the inventive Groups I-II. Thus, it will be an undue burden to examine all of the inventive Groups in one application. Therefore, the restriction requirement is still deemed proper and is made FINAL.

7. Accordingly, Claims 1-13 are withdrawn from further consideration as being directed to a non-elected invention. See 37 C.F.R. §1.142(b) and MPEP §821.03. Examiner suggests that in response to this Office action the non-elected claims 1-13 cited above be canceled to further expedite prosecution.

8. Claims 14-17 and newly presented Claims 18-30 are examined on merits. Applicants to note that Claims 15 and 16 are examined only to the extent that encompasses applicants' election of species in those claims.

9. Upon further review of the claims encompassed in the elected invention, in view of the limitations

in the newly presented Claims 18-30 cited *supra*, applicants' elected invention in Group II cited *supra* is restricted for a species election as follows.

Species Election

10. This application contains claims directed to a method encompassing different compositions comprised of a variety of ingredients. The search for each of the above components is not co-extensive, particularly with regard to the literature search. This is because of the fact that the above-cited inventive group elected for further prosecution incorporates numerous components and numerous ingredients. For example, to conduct a literature search for invention in Group II that is constituted of different encapsulating materials, enzymes, or water soluble polymers, one would be searching for a total number of combinations that will be a factorial of at least 56 with each one of the ingredients up to ingredient number 1 (i.e. 56*55, 56*54, 56*53, 56*52, 56*51, 56*50 and up to---- 56*1). Thus, this group alone will exert an enormous search burden on the Examiner. Additional groups will be those listed in for e.g., Claim 14(a) to 14 (e), Claim 17(a) to 17(e) and different functional groups (e.g., tetra functional, tri functional etc.) in newly presented Claim 23. Thus, the sum total of all the groups to be searched and examined will be a number of geometrical proportions. Therefore, applicants must also make election of species by electing a single species from each of the following categories:

- i. Only one of the substrate among those listed in Claim 19;
- ii. Only one element group from among those materials listed in Claim 20;
- iii. Only one capsulating matrix or class of capsulating matrix among those listed in Claim 23;
- iv. Only one enzyme among those listed in Claim 25;
- v. Only one reactant, and
- vi. Only one polymer among those listed in Claim 30.

11. Applicants are advised that a reply to this requirement must include an identification of each of the species, only one species among the categories i-vi listed *supra*, wherein said species is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election of species. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR §1.141. If claims are added after the election, applicant must indicate which claims are readable upon the elected species [MPEP § 809.02(a)].


Should applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

12. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b) if one or more of the currently named inventors are no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(I).


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30 A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.


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July 9, 2006


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